

Remarks

Upon entry of this amendment, claims 1, 14, 16-18, 20-21, and 26-30 will be pending. Claims 2-13, 15, 19, 22, and 24-25 have been cancelled without prejudice or disclaimer. Claims 26-30 have been added.

New claims 26-30 are supported by the specification and claims as filed. In particular, new claims 26-30 are supported, for example, by paragraphs [0071] through [0075], and Example 3 (paragraphs [0092] and [0093]) of the specification. Accordingly, this amendment introduces no new matter.

Provisional Election With Traverse

The Examiner has required an election under 35 U.S.C. § 121 between Groups I to IX. The Examiner contends that the inventions or groups of inventions are distinct and would require different prior art searches.

In response, Applicants provisionally elect, *with traverse*, the invention of Group IX represented by originally filed claim 25 and new claims 26-30, drawn to methods of detecting Cathepsin O in a biological sample. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final.

With respect to the Examiner's division of the invention into nine groups, and the reasons stated therefor, Applicants respectfully disagree and traverse. Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the Examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Likewise, a search of the polypeptide claims of the invention would also provide useful information for the examination of claims directed to antagonist/inhibitors of Cathepsin O and methods of identifying such antagonist/inhibitors. This is because the function of a polypeptide is frequently demonstrated by the use of antagonist/inhibitors of that polypeptide.

Further, searches of publications directed to polynucleotides, antagonists/inhibitors, and antibodies and the use of those polynucleotides, antagonists/inhibitors, and antibodies would clearly be overlapping. This is so because in many, if not most, publications which describe these molecules, they are described by their function. For example, many, if not most, publications which describe antibodies also demonstrate methods of using the antibodies to detect the antigen. Thus, a search of polynucleotide, antagonists/inhibitors, and antibody claims would also provide the Examiner with art directed to methods in which the claimed polynucleotides, antagonists/inhibitors, and antibodies could be used, for example to treat or diagnose disease states and/or detect Cathepsin O in a sample.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, and antagonists/inhibitors of the invention; as well as methods of identifying inhibitors, methods of treating disease states, and methods of detecting Cathepsin O of the subject invention, would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-IX together in the present application.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.


Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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